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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,242	02/18/2000	Steven D. Hanes	454311-2200.1	9120

20999 7590 07/18/2002

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NEW YORK, NY 10151

EXAMINER

BASKAR, PADMAVATHI

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 07/18/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/507,242

Applicant(s)

HANES ET AL.

Examiner

Padmavathi v Baskar

Art Unit

1645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 05 June 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: please see the attached note.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1,28 and 29.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 5,6,23-26 and 30-39.

Claim(s) withdrawn from consideration: 3,4 and 8-19.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

Continuation of 10. Other: Interview summary 5/23/02(Paper # 14 and 7/10/02 (Paper # 15).

Art Unit: 1645

### ADVISORY ACTION

1. Applicant's amendment filed on 5/17/02 is not entered because the amendment does not place the application in condition for allowance.
2. The proposed amendment to the claims would not overcome the rejections of record under 35 U.S.C. 112, first paragraph for claims 5,6, 23-26 and 30-39, the rejection under 35 U.S.C. 102(b) as being anticipated by Accession Number Y 13120 (May 27 1997) and Accession Number AA182274 (January 6 1997) for claims 5, 6, 27 and 30-31 and the rejection of claims 24 and 39 under 35 U.S.C. 102(b) as being anticipated by Springer et al 1996 (U.S. Patent 5,489,513).

Applicant states that the examples 1-3 support for the broadly claimed (97% homology) invention. However, the Examiner reviewed the examples again and disagrees with the applicant. While the specification supports for an isolated polynucleotide molecule consisting of the nucleotide sequence as set forth in SEQ.ID.NO: 1 and does not support the polynucleotide molecules with 97% homology to SEQ.ID.NO: 1. Applicant, in the proposed amendment canceled the claims with % homology and introduced new claims with comprising language and states that these are 3<sup>rd</sup> generation polynucleotides and with the recitation of functional language there should not be any issue with regard to enablement. It is the position of the Office that the *C.albicans* gene is the functional homolog of budding yeast ESS1, and then it would read on yeast ESS1 and might require a new search and examination with respect to art as well as enablement issues for new claims. The Office considered the "consisting essentially of" language same as "comprising" and applied the art broadly for claims 24 and 39 and for claims 5,6, 23-26 and 30-39 (see paragraph 2 # lines, 2-6).

Art Unit: 1645

3. Claims 1,28 and 29 are free of prior art and are in condition for allowance. Claims 5,6, 23-26 and 30-39 have been rejected as stated above in paragraph # 2. Claims 3,4. and 8-19 are withdrawn from consideration as non-elected invention, said election being made in paper # 6

4. The proposed amendment introduces new claims 40-57 which require further consideration and examination with respect to 35 U.S.C. 112, first paragraph since these claims have not been examined during the prosecution of this application with a open claim language.


5. The Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padma Baskar whose telephone number is (703) 308-8886. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette smith, can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Padma Baskar Ph.D.

7/15/02

  
LYNETTE R. F. SMITH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600